

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**I. Introduction**

Claims 13 and 36 are requested to be canceled. Claims 1, 14, 15, 17, 24, 37 and 39 are currently being amended. Claims 2-10, 21, 25-33 and 43 are withdrawn from consideration. Claims 1-12, 14-35 and 37-45 are pending in this application. No new matter was added.

**II. Allowable Subject Matter**

Applicants appreciate the indication that claims 13-20 and 36-42 would be allowed if rewritten in independent form.

In response, the limitations from allowable claims 13 and 36 have been incorporated into independent claims 1 and 24, respectively. Furthermore, allowable claims 17 and 39 have been rewritten in independent form. Therefore, the application now contains four independent claims 1, 17, 24 and 39, all of which have been indicated as being allowable. Applicants submit that the application is now in condition for allowance.

Applicants respectfully request that withdrawn dependent claims 2-10, 21, 25-33 and 43 be rejoined with the independent claim from which they depend, since the independent claims have been indicated as being allowable.

### **III. The § 112 Rejections Should Be Withdrawn**

Claims 1, 11-20, 22, 24, 34-42 and 44 have been rejected under 35 U.S.C. §112, first paragraph. This rejection is respectfully traversed.

Applicants note that the currently pending independent claims have been indicated as being allowable. Thus, this rejection is considered to be moot.

Furthermore, applicants submit that the claims are fully enabled for their entire scope. The office action asserts that the specification does not enable measurement of acceleration, density, viscosity or to operate an atomic force microscope. However, these specific uses or measurement techniques are not claimed in the present claims.

Claims 1-12 and 14-23 are device claims. These claims are not directed to a particular use of the device. Applicants submit that the specification fully enables the physical structure of the cantilever system recited in these claims.

Claims 24-35 and 37-45 recite a method of actuating a cantilever system. These claims are not directed to a particular use of the system to measure acceleration, etc. Applicants submit that the specification fully enables the actuation method recited in the claims.

As noted in MPEP § 2164.08:

All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also *Plant*

*Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003) (alleged "pioneer status" of invention irrelevant to enablement determination).

The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. (emphasis added)

In the present case, the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. The disclosure fully enables the claimed structure and the claimed actuation method. Thus, the requirements of 35 U.S.C. § 112, ¶ 1 are satisfied.

MPEP § 2164.08 further notes that:

Claims are not rejected as broader than the enabling disclosure under 35 U.S.C. 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *In re Skrivan*, 427 F.2d 801, 806, 166 USPQ 85, 88 (CCPA 1970). One does not look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed. Cir. 1983); *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). In *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the court stated:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

In the present case, the office action admits that the use of a cantilever for measurement of acceleration, density, viscosity or to operate an atomic force microscope are

“valid” (presumably known) uses of a cantilever. Thus, if it was appropriate for one of ordinary skill in the art to use the claimed cantilever for measurement of acceleration, density, viscosity or to operate an atomic force microscope, then one of ordinary skill in the art would know how to do this since such known uses must be presumed to be within the level of ordinary skill in the art.

Furthermore, MPEP 2164.08(b) states that:

The presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling).

In the present case, one of ordinary skill in the art can easily determine if the use of the claimed cantilever for measurement of acceleration, density, viscosity or to operate an atomic force microscope or for other hypothetical uses is not possible without undue experimentation. Thus, even if these uses are determined to be inoperative, this does not render the claims non-enabled.

#### **IV. The Prior Art Rejections Should Be Withdrawn**

Claims 1, 11, 12, 22-24, 34, 35, 44 and 45 were rejected over various prior art references. Applicants respectfully submit that these rejections have been rendered moot because the independent claims 1, 17, 24 and 39 have been amended to include allowable subject matter.

#### **V. Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 11/13/06

By 

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